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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,166	02/19/2004	Christopher A. Quintanilla	ITAG-P2-US	4490

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EXAMINER

HAMZA, FARUK

ART UNIT	PAPER NUMBER
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2155

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04/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/782,166	Applicant(s) QUINTANILLA ET AL.	
	Examiner FARUK HAMZA	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed on February 19, 2004.
Claims 1-11 are pending.
2. The applicant should always use the period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols [®], where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for “the” and “said” within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 10-11 are rejected under 35 U.S.C. 101 because the claimed invention, in light of the specification, encompasses non-statutory subject matter since such reads on (encompass) software or program per se' and/or a carrier wave signal (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106 (New EXAMINATION GUIDELINES FOR COMPUTER-RELATED INVENTIONS).

Claim 10 recites "an appliance", evident by specification it could be software. Means could be a software means. Therefore, claimed the apparatus is software or program per se'.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "each Internet Service Provider" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "its" in line 4 and 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the originating ISP" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the sending ISP" in line 2 and "the receiving ISP" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the method of filtering or labeling" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 7 and 8 recites, "adapted to". "adapted to" language suggests or makes optional but does not require steps to be performed nor limit a claim to a

particular structure and thus does not limit the scope of a claim or claim limitation (see MPEM 2106 (II(C))). Therefore, the claim scope is open ended without meets and bounds and thus indefinite.

Claim 9 recites the limitation "the government" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the serial number" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "each Internet Service Provider" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the originating ISP" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 10, the word "means" is preceded by the word(s) "of integrating" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde et al. (U.S. Patent Number 7,320,021) and in view of Pang (U.S. Patent Number 7,275,082) hereinafter referred as Pang and further in view of Nielsen (U.S. Patent Number 5,870,548) hereinafter referred as Nielsen.

Lalonde teaches the invention substantially as claimed including a method for an authenticity indicator for an electronic communication based on a comparison of domain name data and purported sender data associated with the electronic communication (see abstract).

As to claim 1 and 10, Lalonde teaches a method of tracking electronic mail (e-mail) transmitted by a sender, the method comprising the steps of (abstract):

a) requiring each Internet Service Provider (ISP) to utilize an appliance (Column 3, lines 20-33, Lalonde discloses ISP utilizing server).

b) amending each e-mail transmitted by a sender with an code containing an identification code unique (for a certain period of time) to each email sent through an Internet Service Provider and the serial number of said appliance, thereby allowing each e-mail to be traced back to the originating ISP (Column 3, lines 20-33, lines 56-Column 4, lines 5, Lalonde discloses adding message ID to each mail which is unique and IP address or name of the server).

Lalonde does not explicitly teach the claim limitation of appliance registered with governmental agency.

However, Pang teaches the claim limitation of appliance registered with governmental agency (Column 13, lines 42-55).

It would have been obvious to ordinary skill in the art at the time of the invention to modify Lalonde by registering server (appliance) with governmental agency, which would provide information to government authorities for enforcement. One would be motivated to do such to enhance user's security.

Lalonde does not explicitly teach the claim limitation of encrypted identification code.

However, Nielsen teaches the claim limitation of encrypted identification code (message ID) (Column 18, lines 18-25).

It would have been obvious to ordinary skill in the art at the time of the invention to modify Lalonde and Pang by encrypting the message ID, which would protect the integrity of the message. One would be motivated to do such to enhance user's protection.

As to claim 2 and 11, Lalonde teaches the method of tracking electronic mail (e-mail) according to claim 1 wherein each identification code can be used to cross-reference an ISP's customer login and customer connection records for allowing each e-mail to be traced back to the sender (Column 5, lines 19-Column 6, lines 7).

As to claim 3, Lalonde teaches the method of tracking electronic mail (e-mail) according to claim 1, after the step of amending the e-mail and after the e-mail has been transmitted by the sending ISP, further comprising the step of validating all incoming e-mails by the receiving ISP to ensure that e-mails originate from a registered appliance (Column 4, lines 50-Column 5, lines 18).

As to claim 4, Lalonde teaches the method of filtering or labeling electronic mail (e-mail) according to claim 3 further comprising the step of optionally discarding or labeling e-mails that do not originate from a registered appliance (Column 4, lines 50-Column 5, lines 18).

As to claim 5, Lalonde teaches the method of tracking electronic mail (e-mail) according to claim 1 wherein said appliance is rendered in hardware (Column 7, lines 11-20, a server can be implemented as hardware) .

As to claim 6, Lalonde teaches the method of tracking electronic mail (e-mail) according to claim 1 wherein said appliance is rendered in software (Column 7, lines 11-20, a server can be implemented as software).

As to claim 7, Lalonde teaches the method of tracking electronic mail (e-mail) according to claim 1 wherein the method is adapted to track SMTP mail messages (Column 2, lines 20-38).

As to claim 8, Lalonde teaches the method of tracking electronic mail (e-mail) according to claim 1 wherein the method is adapted to track TCP/IP packets (Column 2, lines 20-38).

As to claim 9, Pang teaches the method of tracking electronic mail (e-mail) according to claim 1 further comprising the step of assisting the government in enforcing a National Do Not E-Mail Registry (Column 14, lines 11-30).

6. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings

of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Knox et al. (U.S. Patent Number 7,076,533) discloses method for monitoring e-mail and website behavior of an e-mail recipient.
- Benowitz et al. (U.S. Pub. No. 2003/0236847) discloses method for authorizing communication.
- Lalonde (U.S. Patent Number 7,320,021) discloses method for generating authenticity indicator.
- Hamilton et al. (U.S. Patent Number 6,981,023) discloses message routing.
- Way (U.S. Pub. No. 2004/0249895) discloses method for rejecting spam email.
- Paul (U.S. Patent Number 6,052,709) discloses method for controlling junk mail.
- Pang (U.S. Patent Number 7,275,082) discloses method for policing junk email.

- Olkin et al. (U.S. Patent Number 6,584,564) discloses secure e-mail system.
- Nielsen (U.S. Patent Number 5,870,548) discloses method for altering sent electronic message.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faruk Hamza whose telephone number is 571-272-7969. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll –free).

Faruk Hamza

Patent Examiner

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Supervisory Patent Examiner, Art Unit 2155

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Art Unit: 2155

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